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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,387	10/16/2003	Bryan McCarrick	66209-0001	9467

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EXAMINER
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LAVINDER, JACK W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/687,387

**Applicant(s)**

MCCARRICK, BRYAN

**Examiner**

Jack W. Lavinder

**Art Unit**

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9 and 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1,2,4-7,9,15-22 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation, "wool extends into said opening", is new matter. The original disclosure states that the opening allows the wearer to touch the wool, but fails to state that the wool extends into the opening. There is no disclosure of an opening having the correct proportions that would allow the wool to extend into the opening.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-9, and 15-22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bergagnini, 5632164 in view of O'Callaghan, 2748577 and the non-patent literature "A Brief Catechism on the Brown Scapular (BCBS)."

Regarding claims 1, 2, and 5, Bergagnini discloses a necklace (39) with a pendant (19, figure 2) secured to the necklace, wherein the pendant has a front and back face forming a cavity therebetween. One of the faces contains an aperture (22, 24) with access to the interior of the cavity (figures 1, 2 and 5), wherein the aperture is located on the outermost surface. Bergagnini places an ornamental array of gemstones within the cavity, viewable and accessible through the aperture (figure 5). Bergagnini's opening (22, 24) is of a size that would allow a piece of cloth to extend into the opening.

Bergagnini fails to disclose a piece of wool located within the cavity.

O'Callaghan discloses

- a necklace (two chains, 25)
- a pair of pendants (10, col. 2, lines 13-14), which are made out of a metal material (col. 1, line 44)
- a piece of cloth (19)
- a cavity, i.e., the cavity formed by the u-shaped cross section and rear surface (20) of the frame piece (11, figure 6) and a front surface (17, left numeral 17 in figure 7) of the pendant for receiving the cloth and exposing the cloth from within the cavity through the oval aperture (22) in the rear surface of the frame (20, figure 6)

O'Callaghan fails to disclose the piece of cloth being wool. However, it is notoriously old and well known to place a piece of wool in a religious scapular in remembrance of the monks of the Carmelite Order. The wool is to symbolize the scapular cloth (working clothing) that the monks use to wear as seen in the first paragraph on page 1 and last

paragraph on page 2 of BCBS. Therefore, it would have been obvious to a person having ordinary skill in the art to place a piece of wool in the pendant of Bergagnini to act as a reminder of the Carmelite Monks in order to have a more meaningful religious effect on the wearer. Also, it would have been obvious to put enough cloth into the pendant so that portions of the cloth extend into the opening in order to ensure that the wearer has the capability of coming into contact with the wool. This reliably ensures that the wearer will be able to experience the religious feelings aroused by touching the wool, i.e., there will be no possibility of the wearer not being able to reach and touch the wool.

Regarding claims 4 and 6-9, O'Callaghan discloses a scapula with two pendants and two chains for placing the religious symbol on the front and back of the wearer in order for people to see the scapula from the front and the back of the wearer. It would have been obvious to add a second pendant to Bergagnini's necklace in order to see the religious symbol from the front and back of the wearer.

Regarding claim 15, Bergagnini discloses an attachment mechanism (43) for holding the front and rear faces together.

Regarding claims 16-17 and 19-21, Bergagnini discloses fixedly mounting the front and rear surfaces of the pendant together, but fails to disclose a pin and a hinge for pivotally attaching the front and rear faces of the pendant. O'Callaghan discloses an attachment mechanism/pin/hinge (12) for holding the front (17) and rear (20) surfaces together. It would have been obvious to a person having ordinary skill in the art to provide a hinge and a pin for pivotally attaching the front face and rear face of the

pendant together. The use of this pivot connection would allow the wearer of the pendant the ability of opening the pendant and replacing the valuable wool with a new piece of wool or other valuable jewelry item. This will provide the pendant with the versatility of being used as a scapula and as ornamental jewelry.

Regarding claims 18 and 22, the examiner takes official notice that the use of a latch on a locket pendant is old and well known to prevent the pendant from prematurely opening and the loss of the contents from the inside of the pendant. It would have been obvious to a person having ordinary skill in the art to add a latch to the already modified pendant to prevent the premature opening of the pendant and the subsequent loss of the cloth material from the inside of the pendant.

#### ***Response to Arguments***

5. Applicant's arguments filed 9/21/2006 have been fully considered but they are not persuasive. The applicant argues that none of the references disclose wool that extends into an opening. First, the applicant's disclosure and drawings fail to disclose wool that extends into an opening in the pendant. Second, Bergagnini's opening (22, 24) is of a size that would allow a piece of cloth to extend into the opening. Also, it would have been obvious to put enough cloth into the pendant so that portions of the cloth extend into the opening in order to ensure that the wearer has the capability of coming into contact with the wool. This reliably ensures that the wearer will be able to experience the religious feelings aroused by touching the wool, i.e., there will be no possibility of the wearer not being able to reach and touch the wool.

The applicant states, page 7, paragraph 1, that the examiner has failed to identify any motivation within the references for the proposed combination. The motivation does not have to be explicitly expressed within the four corners of the references. A proper motivation can come from an explicitly recitation within the references and it can also come from what the references would teach and motivate a person having ordinary skill in the art to make the combination. In this case, the motivation comes from the teachings of the combination of all the references. All the references are involved with necklaces for invoking a feeling within the wearer when the necklace is placed about the wearer's neck. Bergagnini discloses a necklace that invokes a feeling of beauty when the necklace is worn on the wearer's neck. BCBS and O'Callaghan disclose necklaces that invoke religious and piety feelings when the necklace is worn on the wearer's neck. One of ordinary skill in the art would be motivated to make the Bergagnini necklace invoke a more pious feeling by placing wool within the pendant. Both BCBS and O'Callaghan teach the use of wool to make the pendants have a more religious feeling to the wearer. Therefore, the motivation comes from the teachings of the references themselves and what a person having ordinary skill in the art would glean from these teachings.

The applicant argues, pages 7 and 8, that the proposed combination would make Bergagnini inoperative. The placement of a wool cloth in the pendant in place of the ornament would not disable the use of the Bergagnini necklace. The necklace will still afford the wearer a pendant that invokes emotion in the wearer of the necklace. The necklace is still operative and functions as a piece of jewelry.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

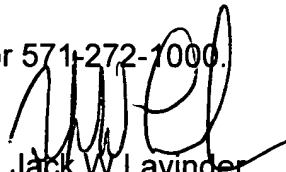
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3677

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jack W. Lavinder  
Primary Examiner  
Art Unit 3677

11/10/2006